



Volume 1, No. 10
October 2000

ONLINE

TODAY

Office of Public Affairs
Washington, DC 20231
703/305-8341

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The USPTO TODAY online is published monthly by the United States Patent and Trademark Office for its customers. The magazine is intended to inform and bring into focus the views and actions of the USPTO. Any product or service names that appear in the magazine are for informational purposes only and do not in any way constitute an endorsement by the USPTO.

Comments and suggestions are welcome by e-mail to ruth.nyblod@uspto.gov.

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In Touch

With the Under Secretary for IP

Q. Todd Dickinson
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

This fall is going to see some exciting developments for the United States Patent and Trademark Office. As the advisor to the Secretary of Commerce and President on intellectual property protection, I will be leading a U.S. delegation to Awaji, Japan, for the 18th Annual Trilateral Conference.

Our Trilateral partners, the European Patent Office (EPO) and the Japanese Patent Office (JPO), will be talking with us about the many ways in which we can improve intellectual property protection, together. This collaboration is essential if the United States is to maintain the strong economic growth that has been a hallmark of the last eight years. It is also a key ingredient in moving toward global harmonization of intellectual property rights, specifically as it relates to patent protection.

We all have the same goals: to make sure that each inventor of every nation is protected equally, and to establish intellectual property rights that encourage innovation and strengthen our economies.

To that end, partnering with the Japanese and European Patent Offices allows us to improve the efficiency and quality of the patent examination process. Our offices are developing jointly the infrastructure and standards needed for electronic communications, including authentication, digital signatures, and encryption. We are helping to develop common standards for Internet-based Patent Cooperation Treaty filing systems, and we are utilizing the Trilateral Network to exchange search strategies, priority documents, and other data.

Along with the progress associated with information technologies, we also are working to give full faith and credit to searches — and eventually examinations — conducted by major patent offices. This will eliminate duplication of effort, decrease patent offices'

workload, and reduce costs to the applicant. More and more IP offices are recognizing the benefits of this type of resource and data sharing.

In fact, since 1992, the Trilateral Offices have participated in concurrent search programs on a limited number of applications in certain technical fields. The results of these programs show that the quality of search improves when examiners of the three Offices were able to confer with each other regarding search strategies and fields of search.

It is in Awaji that we will discuss, and hopefully move forward, on all these matters. Our Offices are looking forward to reviewing the results of the most recent Concurrent Search Program, which will give us some guidance regarding the next steps we need to take to make sure that full faith and credit is given to each other's searches. We also want to discuss procedures for a new 2000 pilot concurrent search program.

I am pleased that the USPTO has the opportunity to come away with an agreement with the JPO and EPO on these procedures during the Awaji meeting. We will then be able to move forward toward our ultimate goal of total global IP harmonization — a hope that is quickly becoming a reality as we enter into the new millennium.

Strategic Quality Framework in Place at USPTO

by R. Jacqueline Dees, Office of Quality Management

October is National Quality Month which makes it a most appropriate time to introduce you to the Office of Quality Management (OQM), the USPTO group responsible for assessing product quality and coordinating office-wide quality improvement activities. Led by Mary Lee [see this month's Faces of USPTO], the USPTO administrator for quality management, and with the support of deputy administrator, Cathy Kern, this critical office guides the efforts directed toward satisfying the needs of both external and internal customers in support of the USPTO Goal: *Provide our customers with the highest level of quality and service in all aspects of USPTO operations.*

The *Office of Quality Management Strategic Framework* is the

blue print that guides OQM's day-to-day operations [See diagram on page 5]. Three strategies — Assessment, Integration and Best Practice Sharing — are used to develop initiatives that will enhance the quality of products and services, improve timeliness, and ensure a satisfied workforce. In order to achieve its mission -- *Guide the USPTO toward performance excellence* -- OQM must demonstrate that the USPTO has made tangible improvement in each of these areas.

In addition to her immediate staff at OQM, the administrator for quality management supervises the Center for Quality Services, the Office of Patent Quality Review, and the Office of Trademark Quality Review. She also chairs the USPTO Quality Council, a cross-functional team comprised of representatives from each USPTO business unit in partnership with the three unions which represent USPTO employees. The Quality Council works closely with the OQM staff to develop initiatives directed toward not only improving the quality of products and services for our external customers, but also improving the quality of work life for our employees. The administrator has important office-wide interaction with the USPTO officials from each of the business units. She has a seat on the Executive Committee, Operations Council, and Policy Council, which integrates the quality perspective into USPTO's decision-making activities.

The Center for Quality Services (CQS), headed by Greg Mullen, provides direction for USPTO customer interface. The CQS personnel manage internal and external surveys, which include the design and administration of surveys and analysis of the results. Additionally, they conduct customer service training for USPTO employees and support a wide variety of customer feedback activities. Customer input is needed to ensure that activities geared toward improving products and services are supportive of customer needs and expectations. The CQS facilitates the process for obtaining customer feedback through focus groups, partnership meetings, technology fairs, workshops, and publicity campaigns.

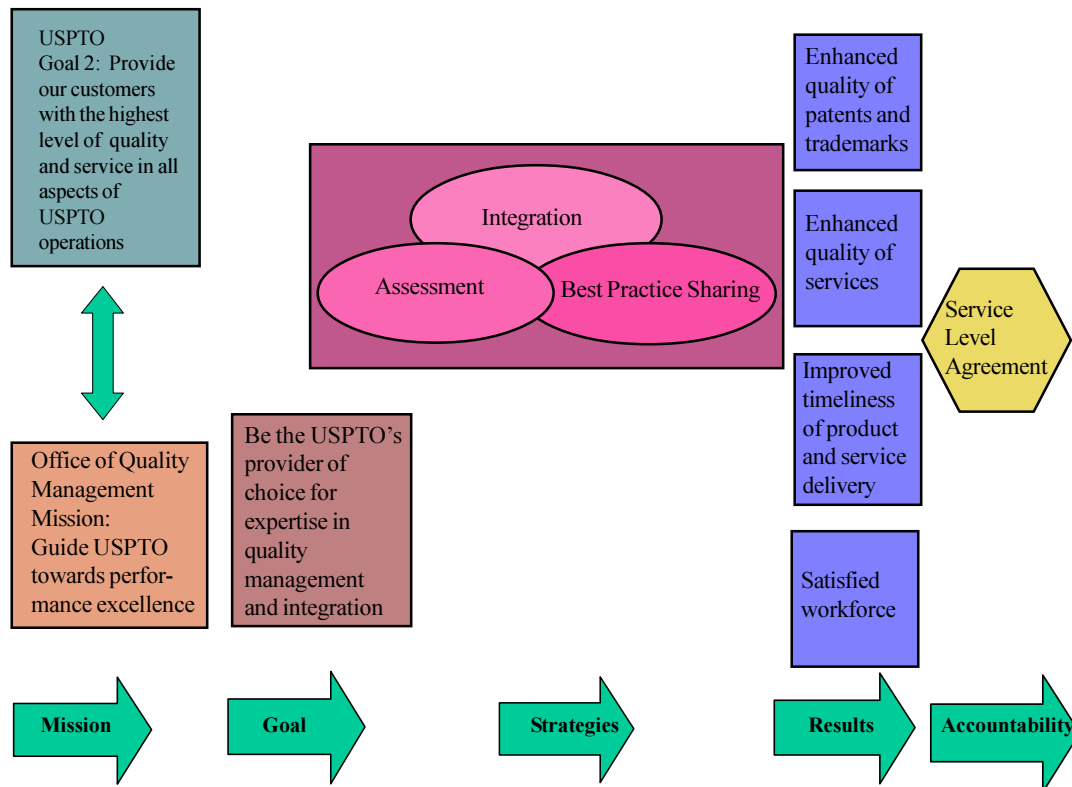
The Office of Patent Quality Review (OPQR), led by Kay Kim, and the Office of Trademark Quality Review (OTQR) provide a program for assessing the quality of patent and trademark examination. As a result of their review functions, OPQR and OTQR provide analysis in the form of reports to patent and trademark management. These reports serve as a tool for educating examiners/examining attorneys. In addition to reporting specific errors, the analysis provides information on recurring problems and trends. The focus of the review for patent applications is threefold: (1) identifying patentability errors, (2) assessing adequacy of the field

of search and proper classification, and (3) assessing proper examination practice and procedures. For trademark applications, the review includes four areas: (1) substantive statutory criteria for registrability, (2) search for confusingly similar marks, (3) proper examination practice and procedure, and (4) proper application of judicial precedents. The information from these reviews helps the business units identify necessary training with the goal of enhancing overall product quality and improving the consistency of examination.

Collectively, the employees of the Office of Quality Management, including CQS, OPQR, and OTQR strive to help improve quality at the USPTO. They realize that the emphasis on quality encompasses more than the timely delivery of products and services, efficiency of operations, and achieving customer and employee satisfaction. The USPTO must continuously move forward on the journey toward *Performance Excellence*. With the support and guidance provided by the OQM, the USPTO is making great strides.

[Look for 2000 customer survey results in upcoming issues.]

Office of Quality Management Strategic Framework 2001 - 2006



Simplifying Patent Practice...

Final Rules Published

by Bob Spar, Director, and Elizabeth Dougherty, Legal Advisor, Office of Patent Legal Administration

The United States Patent and Trademark Office has announced changes to its rules of practice as part of the agency's continuing efforts to streamline and simplify the process of applying for and obtaining patent protection for new inventions. These rule changes are codified in the rule package "Changes to Implement the Patent Business Goals - Final Rule," published in the Federal Register on September 8, 2000, 65 *Fed. Reg.* 54603 (Sept. 8, 2000) and in the Official Gazette on September 19, 2000, 1238 *Off. Gaz. Pat. Office* 77 (September 19, 2000).

In 1999, the USPTO established business goals for the organizations reporting to the commissioner for patents. These "Patent Business Goals" subsequently were adopted as part of the Fiscal Year 1999 Corporate Plan Submission to the President. The one major focus of the Patent Business Goals is to increase the level of service to the public by raising the efficiency and effectiveness of the USPTO's business processes. The PBG-Final Rule makes changes to selected regulations to take a fresh view of the business end of issuing patents and continue a process of simplification.

There are four objectives of the final rules: (1) to reduce the time required to review applications and eliminate unnecessary conditions of applying for and obtaining a patent, (2) to remove impediments to electronic filing, processing, and publishing of patent applications, (3) to reduce costs to the public and to the agency, and (4) to clarify several very technical rules to better inform the public how to proceed and to make it easier for USPTO personnel to determine compliance with the rules. With these objectives in mind, 92 rules of patent practice have been amended, two former rules deleted, and three new rules added.

To assist the public and patent practitioners in becoming familiar with and understanding the PBG-Final Rule package, the agency's Office of Patent Legal Administration has prepared and provided a number of helpful materials which are posted to a PBG - Final Rule home page on the USPTO Web site, <http://www.uspto.gov/web/offices/dcom/olia/pbg/index.html>. These materials include, in part, a summary of the most significant changes, a highlights document, and the Federal Register publication of the PBG-Final Rule. The PBG home page also features PowerPoint slides which detail rule

information, a listing of all USPTO forms that have been changed, frequently asked questions and their answers, and bulletins which summarize the implementation of significant rule changes. The PBG home page, in addition, provides links to other rule-related items and office initiatives. The PBG home page will be continuously updated to provide further information and guidance in dealing with the amended and newly added rules.

Under the amended rules, for example, previously complicated requirements for establishing small entity status, and costly up-front fees associated with the failure to establish small entity status, are eliminated. This allows independent inventors and inventors associated with small businesses to save time and money. Newly added PBG rules permit applications with lengthy computer programs or biotechnology sequence data to be filed on CD-ROM. CD-ROMs and the use of other electronic formats will facilitate the USPTO's migration to an electronic workplace.

Changes of particular significance for the public and practitioners alike, due to their impact on patent practice as either a newly added rule or a substantial change from prior practice, include §§ 1.72, 1.76, 1.85, 1.97, 1.105, 1.121, and 1.155.

Rule 72 has been amended to limit patent abstracts to 150 words in length.

New Rule 76 optionally provides for an "Application Data Sheet" (ADS) containing bibliographic data in a specified format in both provisional and nonprovisional applications.

According to amended Rule 85, extensions of time are no longer permitted to extend the three-month period for filing corrected or formal drawings from the Notice of Allowability.

Rule 97 sets one fee of \$180 for filing an information disclosure statement (IDS) either "before an action that otherwise closes prosecution," or where an IDS is filed after allowance and on or before payment of the issue fee.

To assist examiners in obtaining information that "may be reasonably necessary to properly examine an application or treat a matter therein," new Rule 105 provides explicit authority for an examiner (or other office employee) to require an applicant to submit requested information. The office shall have an implementation plan to ensure that Rule 105 is appropriately used, and not abused.

Rule 121 has been changed to require that amendments be made by

submission of a “clean” replacement paragraph/section/claim.

Lastly, Rule 155, regarding the issue of design patents, has been redrafted to establish a procedure to create an expedited processing and examination procedure for design applications, or a design “rocket docket.”

For further information regarding the PBG-Final Rule, contact Hiram H. Bernstein (703/305-8713) or Robert W. Bahr (703/308-6906), senior legal advisors, or Robert J. Spar, director (703/ 308-5107) Office of Patent Legal Administration, directly by phone, or by facsimile to 703/305-1013, marked to the attention of Mr. Bernstein, or by mail addressed to: Box Comments-Patents, Commissioner for Patents, Washington, D.C. 20231.

TEAS: Continuing Its Winning Ways

by Craig K. Morris, Office of the Commissioner for Trademarks

In the past year, the Trademark Electronic Application System (TEAS, at <http://www.uspto.gov/teas/index.html>) has been recognized for excellence in two national competitions. In May, the TEAS program was selected as a semi-finalist in the *2000 Innovations in American Government Awards Program*, a competition sponsored by The Ford Foundation, The John F. Kennedy School of Government at Harvard University, and The Council for Excellence in Government. Although TEAS was not later named as a finalist, this was still quite an accomplishment since fewer than 8 percent of the initial pool of over 1,300 applicants advanced to the semi-finalist selection round.

In October, the Trademark Operation learned that the panel of judges for the *2000 Government Technology Leadership Awards* had selected TEAS as one of this year’s winners from more than 60 nominations. For the last eight years, the *Government Technology Leadership Awards* program has celebrated successful government initiatives. By honoring meritorious projects and the teams responsible for them, the awards have sought to encourage innovation. The awards salute projects, large and small, that have directly aided the missions of their organizations by boosting efficiency and effectiveness, lowering costs, and/or improving service to the public through original uses of tech-

nology. Based on these criteria, it was clear why TEAS was named a winner!

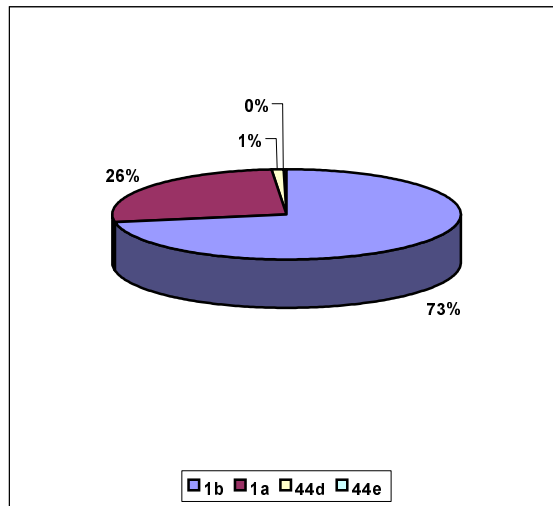
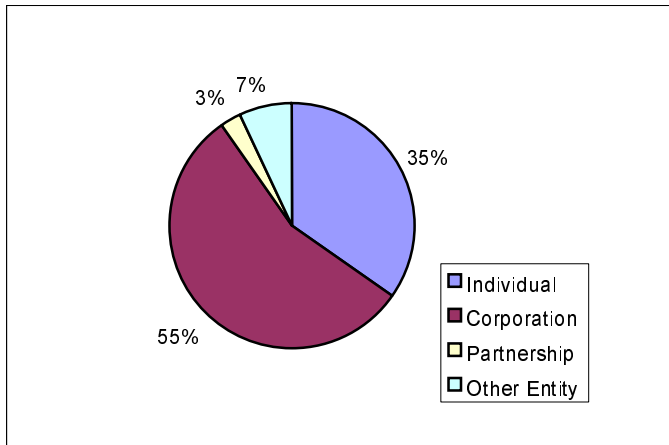
In late November, the Trademark Operation will formally be honored during the Government Technology Leadership Institute Conference at a ceremony at the Reagan International Trade Center, in Washington, D.C. Also, TEAS will be featured in the December issue of *Government Executive Magazine*. Later, the winning projects will be posted on the Government Executive Web site (www.govexec.com/tech/award) for the benefit of others who might learn from these examples of excellence.

While awards certainly reflect very positively on the TEAS project, the real indication of its success is in the widespread use of TEAS. From October 1, 1998 through September 17, 2000, a total of 62,750 applications have been filed electronically. Of this total, 14,486 applications were filed by attorneys. As more attorneys come to understand the advantages of using TEAS, the Trademark Operation expects the number of attorney filings to increase dramatically.

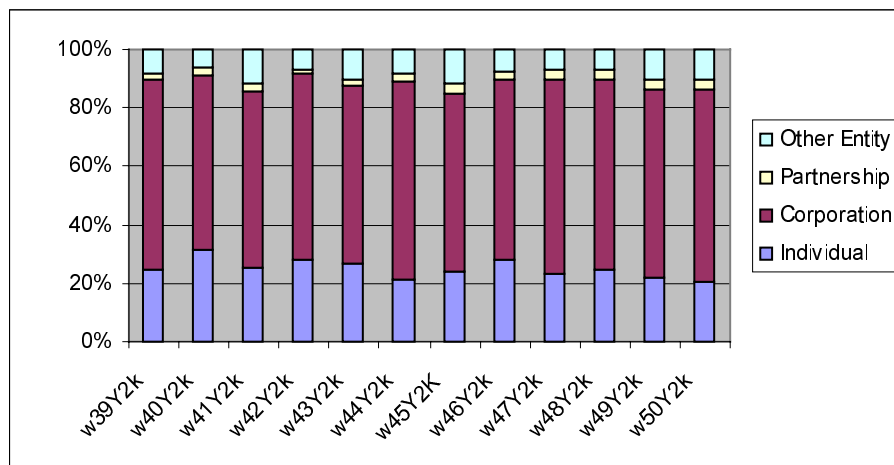
The accompanying charts summarize various aspects of the TEAS project, including the most frequent electronic filers, the filing basis for electronic applications, and the entity type for electronic filers.

TEAS statistics, through 9-17-2000

The top few applicants		The top few countries	
Name	Number	Country	Number
Mattel, Inc.	1,113	Canada	787
Viacom International Inc.	444	Switzerland	409
The Procter & Gamble Co.	391	United Kingdom	302
Novartis AG	269	Germany	252
International Data Group, Inc.	217	Australia	244
Selfish, Inc.	156	Taiwan	217
Nabisco Brands Company	131	France	186
Larry Shultz	118	Sweden	81
Lucent Technologies Inc.	105	Mexico	78
Amazon.com, Inc.	88	Japan	75
PC Flowers & Gifts, Inc.	77	Israel	74
aka Sportswear	74	Hong Kong	69
Marble Sportswear, Inc.	68	Singapore	60
General Motors Corporation	64	Netherlands	43
Microsoft Corporation	59	Brazil	41
Eddie Bauer, Inc.	59	India	37
OnCom, Inc.	59	Italy	37



Entity Type for the past 12 weeks



NOBEL PRIZE WINNERS HOLD PATENTS FOR AWARD WINNING WORK

by Maria Victoria Hernandez, Office of Public Affairs

Alan J. Heeger, Alan G. MacDiarmid and Hideki Shirakawa each hold U.S. patents for the work for which they were honored with the 2000 Nobel Prize for Chemistry.

There are two main patents that deal with this Nobel prize-winning work. Heeger,

MacDiarmid, and Shirakawa are

co-inventors on patent #4,222,903 for p-type doping of polyacetylene. Heeger and MacDiarmid are also co-inventors on patent #4,204,216, which is for n-type doping of polyacetylene. The work covered in these patents helped to lay the groundwork for their study of electrical conductivity in plastics. This discovery led to improvements in film, television screens and windows, and one day may lead to thinner computer screens and even smaller molecular computers.

Chemistry winners discovery led to revolutionizing information technology

Jack S. Kilby, Zhores Ivanovich Alferov, and Herbert Kroemer each hold U.S. patents for the work for which they were honored with the 2000 Nobel Prize for Physics. Jack S. Kilby, received patents for his work miniaturizing integrated circuits (patents #3,138,743 and #4,042,948). Zhores Ivanovich Alferov is a co-inventor on patent #3,958,265 for

the semiconductor light-emitting diode, and

Herbert Kroemer is a co-inventor on two pat-

ents—patent #3,309,553 covering semiconductor solid state radiation emitters and patent #5,013,683, for a method of growing tilted super lattices. The work covered in these patents helped to lay the groundwork for the increasingly faster speed and smaller size of today's information technology, and is the basis for their Nobel Prize. In 1982, Kilby was inducted into the National Inventors Hall of Fame for his work relating to patent #3,138,743.

Physics winners decorated for pioneering work in modern-day information technology

These patents, as well as all patents issued since the first one in 1790, can be viewed on USPTO's web site, www.uspto.gov.

Final Rule Highlights...

Notices of final rules for implementing:
Request for Continued Examination (RCE),
Patent Term Adjustment (PTA), and
18-Month Publication (PG-Pub)

by Robert Clarke, Legal Advisor, Office of Patent Legal Administration

Just about a year ago, President Clinton signed into law the American Inventors Protection Act of 1999. In this short time, USPTO staff have been working diligently to prepare the appropriate rules packages to implement the substantive law changes. Final rules have been published; following are highlights.

RCE Implementation

The final rule notice for RCE was published on August 16, 2000, (65 Fed. Reg. 50092) and modified the interim rules that were in effect on May 29, 2000. The AIPA required that the United States Patent and Trademark Office provide for continued examination of certain applications for patent which were filed on or after June 8, 1995. The AIPA allowed the USPTO to establish appropriate fees for submission of a RCE. The fees, however, were required to be reduced 50 percent for small entity applicants. The appropriate fee was determined by the USPTO to be the same as the basic filing fee for a utility application. Fees for extra claims need only be paid if the claims in excess of the number previously paid for are submitted with or after filing of a RCE.

The interim rules provided that any plant or utility application filed on or after June 8, 1995 could request continued examination by filing a request, payment of the fee, and a submission. Thus, an applicant could file a RCE in an application under a non-final office action. The final rules limited the applications for which a RCE may be filed, to plant or utility applications under an action that closed prosecution, *e.g.*, a final rejection, an action under *Ex parte Quayle*, a notice of allowability, or notice of appeal. This was done because an applicant under a non-final office action has the right to make any amendment suitable as the submission in a RCE as a matter of right without filing a RCE.

The submission accompanying the RCE must meet the reply requirements of 37 CFR 1.111 if either an *Ex parte Quayle* action or a final rejection is outstanding in the application. If the submission does not meet the reply requirements, but is considered by the examiner to be a *bona fide* attempt (37 CFR 1.135), then the reply period set in the prior office action is tolled and an office action is

given, with a new period for reply, notifying applicant what is required to complete the reply. The submission may be a previously filed amendment that was submitted after final, or arguments presented in an appeal brief. If applicant desires the arguments presented in an appeal brief to be considered as the submission, then the applicant must specifically request that they be considered. All after-final amendments will be, to the extent possible, automatically entered in date order unless applicant specifically requests that some or all after-final amendments not be entered.

After it has been decided to seek further examination of an application, the decision on whether to file a RCE or a new continuing application requires an evaluation of cost factors and PTA considerations. A RCE is not a new application, but is a new form of reply allowed by the AIPA and new 37 CFR 1.114. The fact that a RCE is merely a reply in an application has a number of incidental results on what must be included with the RCE, and the procedure for changing information related to the application. A review of these differences is available on the USPTO's Web site at: http://www.uspto.gov/web/offices/dcom/olia/aipa/comparison_of_cpa_practice.htm. Of significant importance is to understand and consider the PTA impact of choosing between a RCE and a continuing application, which is discussed below in relation to the PTA implementation.

The RCE final rule notice also provided for no-cause suspension of action by the USPTO for up to three months on filing either a RCE or a CPA application (37 CFR 1.103(b) and (c)). The entire period of suspension, however, will result in a reduction in any PTA accrued in the application.

PTA Implementation

Utility and plant patents issuing from applications filed on or after May 29, 2000, will be eligible for patent term adjustment for many administrative delays within the USPTO. An application filed on or after May 29, 2000, which is eligible for patent term adjustment (PTA) includes a new application for a utility or plant patent, including a continuation (e.g., a continued prosecution application (CPA)) or divisional application.¹ A request for continued examination (RCE) (37 CFR 1.114) is not a new application and filing a RCE in an application filed before May 29, 2000, will not cause the applicant to be eligible for PTA. See Changes to Application Examination and Provisional Application Practice, Interim Rule, 65 Fed. Reg. 14865 (Mar. 20, 2000); Request for Continued Examination Practice and Changes to Provisional Application Practice, Final Rule, 65 Fed. Reg. 50092 (Aug. 16, 2000); Bahr, Robert, Request for Continued Examination (RCE)

The new statutory “patent term guarantee” establishes three main bases for adjusting the term of a utility or plant patent: (1) if the USPTO fails to take certain actions within specified time frames (35 U.S.C. § 154(b)(1)(A)); (2) if the USPTO fails to issue a patent within three years of the actual filing date of the application (35 U.S.C. § 154(b)(1)(B)); or (3) for delays due to interference, secrecy order, or to successful appellate review (35 U.S.C. § 154(b)(1)(C)). The AIPA requires that any PTA accrued in an application be reduced by the time period during which an applicant fails to engage in reasonable efforts to conclude prosecution of an application. The AIPA also requires that the USPTO make an initial determination of the patent term adjustment with the notice of allowance, and that one opportunity to request reconsideration, or request reinstatement of certain time periods, be provided prior to grant of the patent.

Of particular importance, the second main basis, 35 U.S.C. § 154(b)(1)(B), provides for term adjustment where the USPTO does not issue a patent within three years of the actual filing date of the application, but some time periods do not count towards this three-year period. For example, any time consumed by continued examination under 35 U.S.C. § 132(b) (37 CFR 1.114), imposition of a secrecy order, declaration of an interference, appellate review, or applicant requested delays does not count towards the three-year period. Furthermore, the three-year period begins with the filing date of the application, not any earlier-filed application relied upon for priority under 35 U.S.C. § 120. Accordingly, if an application is filed on May 29, 2000, and a continuation of that application is filed on June 5, 2002, the three-year period will run from June 5, 2002. In addition, in the final PTA rule, the “actual filing date” of an international application which enters the national stage is considered to be the date of commencement of the national stage as to the United States under 35 U.S.C. 371(b) or (f). A RCE of an application filed before May 29, 2000, continues to be ineligible for PTA because the filing of a RCE does not result in a new filing date. Further, filing a RCE, of an application filed on or after May 29, 2000, cuts off any additional PTA due to failure of the USPTO to issue a patent within three years. An applicant, however, may continue to accrue PTA for events after filing the RCE pursuant to the other two PTA bases. For example, if an application was filed on June 1, 2000, and on August 1, 2003, a RCE is filed, and during the processing of the RCE the USPTO fails to meet one of the “time clock” periods by one month, such as acting on a reply within four months of the filing date of the reply, PTA may accrue for

events after the filing of the RCE. If the application issues as a patent on August 1, 2004, the patent will be eligible for a term adjustment of three months (two months for the time from the three year anniversary date to the filing date of the RCE plus one month for missing the four month reply period).

The notice of the final rules implementing PTA was published on September 18, 2000 (65 Fed. Reg. 56365). This notice implements the PTA statutory provision by providing for PTA accrual based on the failure of the USPTO to perform acts within the statutory time periods (see 37 CFR 1.703). The reductions for failure to engage in reasonable efforts to conclude prosecution are implemented by 37 CFR 1.704. The opportunity to request reconsideration, or reinstatement of the time period(s) taken in excess of three months to reply to a notice made by the USPTO are implemented by 37 CFR 1.705.

The USPTO will make an initial determination of the patent term adjustment with the notice of allowance, as required by 35 U.S.C. §154(b)(3)(B)(i). Because this initial determination is made before all of the events giving rise to PTA have occurred, this initial determination (prediction) will state, for example, “The patent term adjustment to date is 857 days. If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the term adjustment will be 1,058 days.” The notice will also state that applicants may be able to obtain more information through the Patent Application Information Retrieval (PAIR) system. PAIR is a means of accessing the USPTO computer records (PALM) for an application over the Internet. The address for PAIR is <http://pair.uspto.gov>. Applicants need a customer number and Public Key Infrastructure (PKI) software to obtain the information for unpublished applications. Information related to patents, and after November 29, 2000, for published applications, is available to the public through PAIR.

PG-Pub Implementation

The statutory mandate to publish applications for patents required by the American Inventors Protection Act of 1999 is one of the most fundamentally significant changes to the American patent system in this century. The statute requires the USPTO to publish an application 18 months after the application’s filing date, or the filing date of a prior application, including a foreign application, if the US application claims benefit to the prior application’s filing date. The statute excludes from the universe of applications that must be published: any application filed before November 29,

2000; any design application; any provisional application; applications subject to a secrecy order; any application no longer pending on its publication date; and any application in which the applicant files a request, on filing, that the application not be published. The request that an application not be published may only be filed in applications where applicants have not and will not file an application for the same invention in a foreign country, or under an international agreement, that requires publication at 18 months from filing or benefit date. Essentially all applications filed in foreign countries and applications filed under the Patent Cooperation Treaty publish on that date. The statute also provides for publication of utility and plant applications filed before November 29, 2000, but only if applicant requests it. This is called voluntary publication.

In implementing the statute, the USPTO had to consider that the publication will have prior art effect in the same manner as patents, *e.g.*, starting from the earliest effective filing date of the application. Thus, the publication will likely become the predominant form of prior art used by examiners and the public because it will be published earlier than corresponding patents and because applications will be published regardless of whether a patent is granted on the application. This prior art impact required that the USPTO ensure that the publication be suitable for use as a prior art document, *e.g.*, be computer searchable, include suitable drawings, abstracts, and titles and be classified for searching and retrieval purposes. The USPTO was also concerned by the somewhat competing concerns of avoiding unnecessary costs on the applicant in preparing a suitable publication document and ensuring the availability of the application's file wrapper for review by the examiners. Because of these concerns, the USPTO will prepare an image database of applications, as filed, which will be used as the source file for publication purposes. This will avoid both disrupting examination of the applications for which publication is required and unnecessary costs. This up-front data capture requires a change in the up-front review of applications to ensure that the publication is suitable as a prior art document, *e.g.*, drawings of sufficient quality for use as a prior art document, text of suitable quality, *etc.* Applicants who decide that an application filed before November 29, 2000, should be published, or decide that some amended form of the application is desired to be published, must timely file an electronic version of the application using the USPTO's Electronic Filing System (EFS) authoring and submitting software package. Thus, the publication process will not interrupt the availability of the application during examination, and in most instances we will have reduced costs when compared to creating the document in the same manner as a patent is created today.

The USPTO will provide electronic access to the public to published applications via the Internet, but may not publish paper copies of published applications, nor give notice of the publication in an Official Gazette. Anyone may obtain a paper copy of the publication merely by printing the viewed document obtained by use of the Internet, or by making a request (with a fee) to the USPTO for a copy. Following publication, access to file history information for an application will be available to the public via the Internet. Should a member of the public have an interest in the contents of the proceedings, a copy of the file, including all papers in the file, will be provided for a fee. Unfettered access to the actual file wrapper, as is provided for patented files, will not be provided while the application is pending because of the office's concerns about not interrupting the examination process. A member of the public will also be able, for a fee, to bring to the USPTO's attention a limited number of printed publications within a short period after publication for the examiner's consideration during examination of the (published) application. See 37 CFR 1.99 (a new rule).

The notice of final rules implementing PG-Pub was published on September 20, 2000 (65 Fed. Reg. 57023) and becomes effective on November 29, 2000. In addition to this notice the USPTO anticipates that an O.G. notice concerning implementation of amended 35 USC 102(e) will be published.

Information concerning the Office's implementation efforts is available over the Internet via : <http://www.uspto.gov/web/offices/dcom/olia/aipa/index.htm>. If information is desired on a particular subject please call Robert Clarke at 703/305-9177, Karin Tyson at 703/306-3159 or Bob Spar at 703/308-5107.

¹Note the discussion in comment 5, 37 CFR 1.702(a), *Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 56366, 56375 (Sept. 18, 2000).

WIPO/IFIA International Symposium in Buenos Aires, Argentina

by Elaine Wu, Attorney-Advisor, Office of Legislative and International Affairs

The United States Patent and Trademark Office recently participated in the Inventors at the Dawn of the New Millennium International Symposium in Buenos Aires, Argentina. I accompanied Nestor Ramirez, supervisory patent examiner in Technology Center 2800, to the symposium. The World Intellectual Property Organization (WIPO) and the International Federation of Inventors' Associations (IFIA) sponsored the symposium, held from September 5-8, with the assistance of the government of Argentina and the Argentine Association of Inventors.



Speakers and panelists represented: Argentina, Brazil, Cuba, Finland, Hungary, India, Malaysia, Mexico, the Netherlands, Peru, Poland, and the United States.

The purpose of the symposium was to discuss and consider the role of inventors and innovators facing the challenges of the new millennium — world wide communication through the internet, increased competition, and accelerated development of emerging technologies. The symposium could not come at a better time. The role of the independent inventor is an increasingly important one. Particularly for many of the emerging economies around the world, the work that the independent inventor is essential. In these countries, it is often the independent inventor and small business enterprise that generates the innovation needed to spur these countries to begin the step toward industrialization. The well-attended symposium provided a forum in which independent inventors' organizations and offices, including the USPTO's Office Independent Inventor Programs, could convene to discuss a variety of important topics facing all independent inventors regardless of nationality.

These topics included such diverse subjects as how the internet and new information technologies influence the work of inventors and innovators in small business enterprises; patenting strategies for the small business enterprise; how to protect the rights of employed inventors; and the important role of support services for inventors. During round table discussions, various inventors representing Cuba, Hungary, Mexico and the Netherlands talked about their experiences in initiating start-up companies. At another round table discussion, panelists from Brazil, Peru, and Mexico discussed how the various independent inventors' organizations could enhance their cooperation with each other using the Internet and new information technologies.

Mr. Ramirez discussed the role of the Office of Independent Inventor Programs at the USPTO, and in general, how patent offices can encourage inventive and innovative activities. The participants of the conference were particularly interested in learning about the USPTO's automated patent searching and filing systems, and its advanced Internet Web site. Both systems are considered invaluable tools in encouraging independent inventors to capitalize on their inventions.

Faces of the USPTO

Mary C. Lee, administrator, Office of Quality Management, joined the Patent and Trademark Office in 1973 immediately after receiving her undergraduate degree in chemistry from the State University of New York. She earned a graduate level Certificate of Advanced Public Management from the Maxwell School of Citizenship and Public Administration at the Syracuse University in 1998.

Ms. Lee is currently serving as the administrator for the Office of Quality Management, the USPTO group responsible for assessing product quality and coordinating office-wide quality improvement activities. This critical office, which includes the Center for Quality Services, the Office of Patent Quality Review, and the Office of



Trademark Quality Review, guides the efforts directed toward satisfying the needs and expectations of both external and internal customers.

Ms. Lee also serves as a member of the USPTO Executive Committee and Operations Council and chairs the USPTO Quality Council, a cross-functional team comprised of representatives from each USPTO business unit in partnership with the three unions which represent USPTO employees. The Quality Council works closely with the Office of Quality Management staff to develop initiatives directed toward not only improving the quality of products and services for USPTO's external customers, but also improving the quality of work life for the agency's employees.

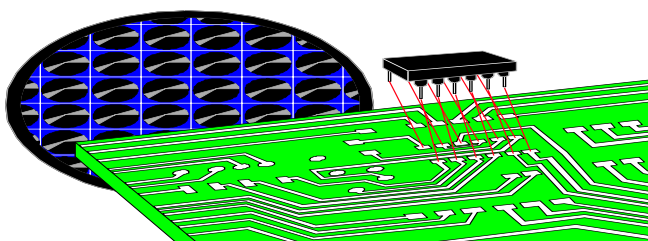
Ms. Lee served as a chemical patent examiner responsible for examining applications in the field of heterocyclic organic chemistry and pharmaceutical compositions from 1973 through 1978. She was promoted to the position of primary examiner in 1978 and supervisory patent examiner of Art Unit 1201 in 1987. In the SPE position she led an art unit responsible for the examination of patent applications in the field of bio-affecting drugs selected from heterocyclic organic compounds, phosphorus esters, sulfonic acid esters, carbonates and nitriles. In 1995 Lee was appointed to the Senior Executive Service as a deputy director of the Biotechnology Group 1800, and in 1998 she was reassigned to the position of director of Groups 1620 and 1640 in Technology Center 1600. These groups examine inventions related to carbohydrate chemistry, non-heterocyclic organic chemistry, bacterial immunology, antibody engineering, cancer immunology, viral immunology, cellular immunology, receptors, cytokines, recombinant hormones and plants.

While serving as a member of the patent organization, Lee served on numerous details and work assignments including assignments to the Office of the Assistant Commissioner for Patents, Office of Petitions, Office of Classification and Documentation, Office of Automated Concepts and Implementation, and the Office of Automation. Ms. Lee also served on numerous teams within the USPTO including labor relations negotiation teams, a reengineering team, quality improvement teams, and automation committees and has represented the USPTO on a variety of interagency and private sector teams. Additionally, she has been a leader in helping the USPTO streamline examination process and procedures to reduce internal cycle time and improve quality of examination and customer service. She led various special projects, such as a team examination initiative and a team responsible for creating examination search guidelines, in an effort to increase the consistency and efficiency of the patent examination process.

Semiconductor Customer Partnership Meeting

The United States Patent and Trademark Office will hold the fall meeting of the Semiconductor Customer Partnership on Tuesday, October 31, 2000, from 9 a.m. to 4 p.m. in the Commons Building of *Advanced Micro Devices*, located at One AMD Place in Sunnyvale, California. The meeting will provide another opportunity for the continued exchange of ideas toward improving the quality of the examination process and other services. As in the previous meetings, the agenda will include a session devoted to customer presentations. In addition, there will be a roundtable session in the afternoon.

The roundtable session is intended as a forum for



customers and the semiconductor workgroup staff to discuss concerns relating to the patent examination process in the semiconductor workgroup.

If you would like further information about the meeting or the partnership in general, please contact Tom Thomas (tom.thomas@uspto.gov) at 703-308-2772. Participation in the partnership is open to anyone interested in intellectual property issues facing the semiconductor industry. If you are interested in attending the meeting, please contact Sharlamar Taliaferro (sharlamar.taliaferro@uspto.gov) by phone at 703-305-4094 or by e-mail. Details including the meeting agenda will be available prior to the meeting.

Note:

The Semiconductor Customer Partnership is designed and developed to be a forum to share ideas, experiences, and insights between individual users and the USPTO. The USPTO does not intend to use these customer partnership groups to arrive at any consensus. Invitations to

participate will indicate that individual opinions are sought, rather than a group consensus and that the meetings are intended to be informal in nature and have varying participants. These customer partnership groups are formed with full recognition of the USPTO's responsibility under the Federal Advisory Committee Act (FACA), and these customer partnership groups are not established as FACA compliant committees.

USPTO Customer Outreach

Lecture Series and Workshops

In the interest of providing better service to its customers, the U.S. Patent and Trademark Office operates a secure VideoConference Center. Linked to its three Partnership Patent and Trademark Depository Libraries, it provides board hearings, examiner interviews, and lectures. Contact your closest partnership library for more information and local times:

Sunnyvale Center for Innovation, Invention and Ideas

Sunnyvale, California

Phone: (408) 730-7290

Great Lakes Patent and Trademark Center

Detroit, Michigan

Phone: (313) 833-3379

South Central Intellectual Property Partnership at Rice University

Houston, Texas

Phone: (713) 348-5196

Video Conference Lectures

<u>Schedule Date</u>	<u>Topic</u>	<u>Lecturer</u>	<u>Duration Of Lecture</u>	<u>Time (ET)</u>
10/17/00	PCT I	tbd	3 hours	1pm - 4pm
10/19/00	PCT II	tbd	3 hours	1pm - 4pm
11/14/00	Double Patenting	tbd	1 - 2 hours	1pm - 2/3pm
11/16/00	Proposed New Rule change	tbd	2 hours	1pm - 3pm
11/28/00	Petitions	tbd	2 hours	1pm - 3pm
11/30/00	State Street Case	tbd	2 hours	1pm - 3pm
12/5/00	PCT I	tbd	3 hours	1pm - 4pm
12/7/00	PCT II	tbd	3 hours	1pm - 4pm
12/12/00	E-TEAS	tbd	2 hours	1pm - 3pm
12/14/00	Trademark Tips for Paralegals	tbd	2 hours	1pm - 3pm

The United States Patent and Trademark Office is currently holding free, one-day, educational workshops across the country at Patent and Trademark Depository Libraries detailing implementation of the American Inventors Protection Act of 1999 (AIPA) and introducing the agency's electronic commerce initiatives.

The **Patents 2000 Customer Outreach Program** is designed to help registered patent attorneys/agents, legal staff and independent inventors understand the impact of the AIPA, which became law in late 1999.

The highlights of the electronic commerce segment are Patent Application Information Retrieval (PAIR) - How to access information about your patent application or any issued patents/published application via the Internet; Electronic Filing System (EFS) - How to file a patent application online; Changes to PAIR and EFS to support implementation of the AIPA and whether or not you will need to use PAIR and EFS as a result of AIPA implementation; and Public Key Infrastructure (PKI) - How the USPTO protects your application information on the Internet.

In each city, there will be two workshops, one planned for attorneys and large corporations and one planned for independent inventors. The workshops will be presented as interactive lectures with ample opportunity for questions and answers.

Reservation and contact information for USPTO's Patents 2000 Customer Outreach Program workshops follows.

Engineering Library, University of Washington; Seattle, WA
October 16 and 17
Contact: (206) 685-8371; englib@u.washington.edu

Chicago Public Library; Chicago, IL
October 30 and 31
Contact: (312) 747-4477

Milwaukee Public Library; Milwaukee, WI
November 2 and 3
Contact: (414) 286-3000

The Public Library of Cincinnati and Hamilton County, Cincinnati, OH
November 13 and 14
Contact: (513) 369-6971 or e-mail: tkenig@plch.lib.oh.us

San Diego Public Library, San Diego, CA
November 29 and 30
Contact: (619) 236-5813 or e-mail: science@library.sannet.gov

Broward County Main Library, Ft. Lauderdale, FL
December 6 and 7
Contact: (954) 357-7439 or (954) 357-7872

University of Utah Marriott Library, Salt Lake City, UT
December 14 and 15
Contact: (801) 581-8558 or e-mail: dmorriso@library.utah.edu

For more information about the Patents 2000 Customer Outreach Program, please go to www.uspto.gov and click on American Inventors Protection Act or the Patent Electronic Business Center.



Open House Program

presented by

BIO and the U.S. Patent and Trademark Office
Technology Centers 1600 and 2900
and the Search and Information Resource Administration

Audience:

All biotechnology, organic chemistry,
pharmaceutical, and design practitioners

Date:

Wednesday, October 18, 2000
Program begins at 8:30 am

Location:

The Crystal Forum
1999 Jefferson Davis Highway, Arlington, Virginia

Luncheon Speaker:

The Honorable Alan D. Lourie
Circuit Judge, Court of Appeals for the Federal Circuit

Topics Include:

automation update, patent operation issues,
utility/written description guidelines, proposed rules,
biotech policy, USPTO strategic planning,
appeals and interferences, design issues,
tours of the technology center,
meet and greet USPTO personnel,
automation demos including PatentIn, PAIR, EFS

Town Hall Meeting
with open microphone for Q&A

Panel discussions with Q&A on
bioinformatics, organic chemistry, pharmaceuticals,
gene therapy, transgenic animals, immunology, combinatorial
chemistry, design, and technology center operations

CLE Credits

Reservations are required.

Please call 703/308-1234 for more information or to RSVP. Registration fee for the program with lunch on October 18 is \$100
